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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,024	12/08/2000	Paula S. Newman	A0836	1622

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EXAMINER

NGUYEN, THANH T

ART UNIT PAPER NUMBER

2144

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/732,024

Applicant(s)

NEWMAN ET AL.

Examiner

Tammy T. Nguyen

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on January 20, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-18 and 20-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



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***Detailed Office Action***

1. In view of the Appeal Brief filed on June 20, 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims 1, 3-10, 12-18, and 20-27 are reopen for examination.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim Is rejected under 35U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
4. Claim 18 is not limited to tangible embodiments. The claim recited “An information storage media comprising...” is nonstatutory. Since claim 18 recited “ An information storage media comprising...” is just limited to a functional descriptive materials consists of computer program per se, instead of being defined as including tangible embodiments (i.e., a computer readable storage medium such as memory device, storage medium, etc.,). As such, the claim is not limited to statutory subject matter and is therefore nonstatutory. To overcome this type of 101 rejection, examiner suggests applicants to amend the claim to include computer readable storage medium to store computer codes (for example, the claim should be amended as “A computer-readable storage media comprising...” See MPEP 2106 section V. DETERMINE WHETHER THE INVENTION COMPLIES WITH 35 U.S.C 101 under subsection 1. Nonstatutory subject matter.

### ***Claim Objections***

5. Claims 24, and 26 are objected to because of the following informalities: “the system of claim...”. Appropriate correction is required.

### ***Allowable Subject Matter***

6. Claims 4, and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claims 10, 18, and 26 have similar limitations as claim 1; therefore, they are rejected under the same rationale.
8. Claims 14, and 22 have similar limitations as claim 6; therefore, they are rejected under the same rationale.
9. Claims 4, and 13 have similar limitations as claim 4; therefore, they are rejected under the same rationale.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 3, 5, 7-9, 12, 15-17, 20, 23-25, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Mithras C. Maurille., (USPN 6,484,196 – Date of Patent: November 19, 2002, herein referred to as “Maurille”).

12. As to claim 3, Maurille teaches the invention as claimed, wherein the step of identifying logical components comprises generating a message tree that includes nodes that recursively divide each of the messages into a main body, nested excerpts from other messages, and at least one subdivision wherein each subdivision is divided into lowest-level logical components (col.10, lines 35-45, and col.14, lines 15-60).
13. As to claim 5, Maurille teaches the invention as claimed, wherein the step of decomposing comprises: logically concatenating subsections of the body that is separated by incorporated excerpts; and applying a weighted finite state machine to the result (col.1, line 55 to col.2, line 10).
14. As to claim 7, Maurille teaches the invention as claimed, wherein the document includes a compressed form of each of the messages (Fig.7C compress email).
15. As to claim 8, Maurille teaches the invention as claimed, wherein each of the compressed forms comprises non-extraneous parts of the primary text and abbreviated forms of incorporated excerpts (col.4, lines 25-35).
16. As to claim 9, Maurille teaches the invention as claimed, wherein the document includes a replies as annotations form for each of the messages (col.14, lines 15-60).
17. As to claim 12, Maurille teaches the invention as claimed, wherein the processor is adapted to generate a message tree that includes nodes that divide each message into a main body and into excerpts from other messages and further into lowest-level logical components (col.10, lines 35-45, and col.14, lines 15-60).
18. As to claim 15, Maurille teaches the invention as claimed, wherein the document includes a compressed form of each of the messages (Fig.7C compress email).

19. As to claim 16, Maurille teaches the invention as claimed, wherein each of the compressed form contains non-extraneous parts of the primary text (col.4, lines 25-35).
20. As to claim 17, Maurille teaches the invention as claimed, wherein the document includes a replies as annotations form for each of the messages (col.14, lines 15-30).
21. As to claim 20, Maurille teaches the invention as claimed, further comprising information that generates a message tree that includes nodes that divide each message into a main body and into excerpts from other messages and further into lowest-level logical components (col.10, lines 35-45, and col.14, lines 15-60).
22. As to claim 23, Maurille teaches the invention as claimed, wherein the medium includes a compressed form of each of the messages (Fig.7C compress email).
23. As to claim 24, Maurille teaches the invention as claimed, wherein each of the compressed form contains non-extraneous parts of the primary text (col.4, lines 25-35).
24. As to claim 25, Maurille teaches the invention as claimed, wherein the medium includes a replies as annotations form for each of the messages (col.14, lines 15-60).
25. As to claim 27, Maurille teaches the invention as claimed, wherein the medium is one of a human readable document and a computer readable document (Fig.2).

### *Conclusion*

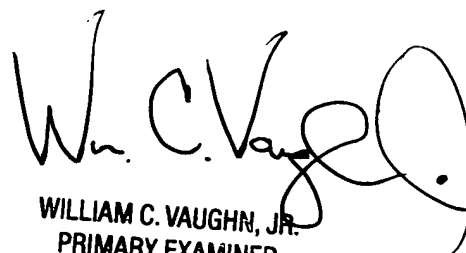
26. Any inquiries concerning this communication or earlier communications from the examiner should be directed to **Tammy T. Nguyen** who may be reached via telephone at **(571) 272-3929**. The examiner can normally be reached Monday through Friday between 8:00 a.m. and 5:00 p.m. eastern standard time.

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If you need to send the Examiner, a facsimile transmission regarding this instant application, please send it to **(703) 872-9306**. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, **VAUGHN JR WILLIAM**, may be reached at **(571) 272-3922**.

*TTN*

April 3, 2006

  
WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER